

REMARKS

In the Final Office Action dated January 22, 2004, the Examiner rejected claims 1-37 as being unpatentable under 35 U.S.C. §103(a) over DiRienzo, U.S. Patent No. 6,006,191, in view of Howards Koritzinsky et al., U.S. Patent No. 6,598,011. Applicant submits that the claims are patentable over the cited references because the Howards Koritzinsky et al. reference is disqualified as prior art under 35 U.S.C. §103(c).

Previously, in responding to the Final Office Action, Applicant represented that the present application and the Howards Koritzinsky et al. reference were commonly assigned at the time the present invention was made. Therefore, the Howards Koritzinsky et al. reference is not valid prior art under 35 U.S.C. §103(c). However, in the Advisory Action, the Examiner maintained the rejection stating that no assignment of record could be located for the Howards Koritzinsky et al. reference. Specifically, the Examiner stated:

Applicants argue in substance that according to MPEP 706.02 and its subsections, a clear and conspicuous statement be made of the common ownership or obligation of assignment and this statement was made in the response 11/7/03 (paper number 3) to a previous Office Action mailed 10/9/03 (paper number 2). In addition, the Applicant notes that MPEP 706.02(1)(2) states that evidence of common assignment may be provided, but is not required. It is respectfully submitted that the Examiner has reviewed and checked the assignment data of the Howards Koritzinsky (011) patent (application 09/199622) and no assignment has been recorded and no assignment papers indicating an assignment of the 011 patent (application 09/199622) was made to General Electric Company or one of its wholly owned and controlled subsidiaries at the time the instant application 09/619957 was filed. Furthermore, MPEP section 706.02(1)(2) heading II also states that in rare instances, the Examiner may have independent evidence as mentioned above that raises a material doubt as to the accuracy of applicant's representation of either (1) the common ownership of, or (2) the existence of an obligation to commonly assign, the application being examined and the applied U.S. patent or U.S. patent application publication reference. In such cases, the Examiner may

explain why the accuracy of the representation is doubted, and require objective evidence of common ownership of, or the existence of an obligation to assign, the application being examined and the applied reference as of the date of invention of the application being examined. The Applicant(s) may submit, in addition to a statement regarding common ownership, the following objective evidence:

- A. Reference to assignments recorded in the U.S. Patent and Trademark Office in accordance with 37 CFR Part 3 which convey the entire rights in the applications to the same person(s) or organization(s);
- B. Copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s) are filed in each of the applications;
- C. An affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership, which affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization; and
- D. Other evidence is submitted which establishes common ownership of the applications.

Since no evidence has been provided to establish common ownership, the applied reference of Howards Koritzinsky et al. qualifies as prior art and the rejection is maintained.

Applicant again asserts that the Howards Koritzinsky et al. reference and the claimed invention were under an obligation of assignment to the same entity at the time the present invention was made. Specifically, all of the inventors of the Howards Koritzinsky et al. patent and the present application were under an obligation of assignment to General Electric Company or one of its wholly owned and controlled subsidiaries at the time the present invention was made.

In addition to the clear and conspicuous statement above, a signed Declaration in accordance with M.P.E.P. § 706.02(1)(2) is included herewith. Specifically, the document

entitled Declaration of Christian G. Cabou is submitted as objective evidence of common ownership in accordance with M.P.E.P. § 706.02(l)(2)(C) and (D). In light of this Declaration and the definition of prior art under 35 U.S.C. §103(c), Applicants respectfully request removal of the Howards Koritzinsky et al. reference as prior art against the claims of the present application. Further, Applicants assert that claims 1-37 are patentable over the DiRienzo reference. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of claims 1-37.

The Commissioner is authorized to charge the required fee for the Request for Continued Examination (RCE), in the amount of \$770.00 to Deposit Account No. 50-2402; Order No. 15-SV-5489/YOD (GEMS:0085).

Conclusion

Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Date: June 22, 2004

Ralph A. Graham
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
James F. Kohli

Serial No.: 09/619,957

Filed: July 20, 2000

For: SECURE MEDICAL FACILITY
REPORT PREPARATION AND
DELIVERY

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Group Art Unit: 3626

Examiner: Morgan, Robert W.

Atty. Docket: GEMS:0085/YOD
15-SV-5489

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

6-22-04

Date

Carla DeBlaw

Carla DeBlaw

DECLARATION OF CHRISTIAN G. CABOU

Dear Sir:

1. My name is Christian G. Cabou, and I am employed as General Counsel of General Electric Global Research, with a professional address of 1 Research Circle, Niskayuna, New York 12309.

2. I am aware of U.S. Patent No. 6,598,011, entitled "Medical Diagnostic System Services Interface" filed by Howards Koritzinsky et al. on November 25, 1998, and issued on July 22, 2003.

3. At the time of the filing of the application that resulted in the Koritzinsky et al. patent, I served as Senior Counsel of Global Intellectual Property at General Electric Medical Systems in Waukesha, Wisconsin, and oversaw a legal team under whose direction the Koritzinsky et al. patent application was prepared and filed.

4. At the time the Koritzinsky et al. application was filed no Assignment document was prepared and executed by the inventors due to transitional issues involved with the organization of a subsidiary service company to be under the common ownership or control of General Electric Company, Schenectady, New York.

5. Accordingly, on information and belief, all of the inventors listed on the Koritzinsky et al. patent were employees of General Electric Company, or of a commonly owned subsidiary or affiliate company, and were under an obligation of assignment of the intellectual property defined by the Koritzinsky et al. patent to General Electric Company or to a subsidiary or affiliate, and in particular to GE Medical Technology Services, Inc., a Delaware corporation, with a principal business address at N25W23255 Paul Road, Pewaukee, Wisconsin 53072.

6. As an official of the corporation to which all of the inventors were under an obligation of assignment, the statements made in this Declaration are intended to act as evidence that the Koritzinsky et al. patent was subject to an obligation of assignment to General Electric Company of Schenectady, New York, or a to company under entire ownership or control of General Electric Company.

7. I declare further that all statements made herein are of my own knowledge, are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Dated: June 17, 2004

By: Christian G. Cabou
Christian G. Cabou
General Counsel, GE Global Research